

**REMARKS**

Claims 3 and 10 are pending in this application after entry of this paper. Claims 1 and 4-9 have been previously withdrawn with traverse in a response to a restriction requirement. Claim 2 has been canceled. Applicants reserve the right to pursue the subject matter of the withdrawn and canceled claims in a divisional or continuing patent application. Claim 3 has been amended to incorporate the subject matter of Claim 2 and to further clarify the claimed invention. Claim 10 has been amended to omit non-elected subject matter. No new subject matter has been introduced by these amendments.

These amendments have been made solely to further prosecution of the instant application. Applicants respectfully request reconsideration in view of the claim amendments and the following remarks.

**Response to Claim Objections***Claim 3*

Claim 3 has been objected to because the claim was drawn to non-elected subject matter. Claim 3 is drawn to an isolated DNA having a nucleic acid sequence shown in SEQ ID No. 1, the full complement of this sequence which encodes a protein, and a DNA encoding a protein that has an amino acid sequence shown in SEQ ID No. 2. Applicants believe that these components of claim 3 overlap in scope and can be used together as required by MPEP §802.01. Furthermore, these components are linked because the full complement of SEQ ID No. 1 encodes a protein whose

sequence is shown in SEQ ID No. 2. Under MPEP §809, related and linked claims should be examined together.

*Claim 10*

Claim 10 has been objected to because the claim was drawn to non-elected subject matter. Claim 10 has been amended to omit non-elected subject matter and thus the objection has been rendered moot. Applicants respectfully request reconsideration and withdrawal of the claim objections in view of the claim amendments and for the above reasons.

**Response to 35 U.S.C. §101 Rejections**

Claims 2 and 3 have been rejected under 35 U.S.C. §101 because the Examiner alleges that the claims describe products of nature. Applicants respectfully traverse this rejection. However, in order to expedite prosecution of the instant application, applicants have amended the claims, thereby addressing the Examiner's concerns. These amendments are in no way an admission of a lack of utility. Specifically, claim 2 has been canceled and claim 3 has been amended to describe a DNA that is isolated with the desired characteristics described within the claims in order to address the Examiner's concerns. Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §101 to claims 2 and 3 in view of the claim cancellation and amendments.

**Response to 35 U.S.C. §112, First Paragraph, Rejections***Claim 2*

Claim 2 has been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner contends that this claim encompasses practically “any piece of DNA,” because it recites “a DNA of a gene” and “a sequence.” Applicants respectfully disagree.

Claim 2 has been canceled and its subject matter has been partly incorporated into claim 3(c). The DNA of claim 3(c) “encodes a protein having an amino acid sequence of SEQ. ID No. 2” and therefore applicants believe that the DNA would not be interpreted by one skilled in the art as being “any piece of DNA.” As claim 3 now reads, the DNA that is claimed comprises a specific nucleotide sequence (187-1389 of SEQ ID No. 1), the DNA complement of this nucleotide sequence that encodes a protein, and a DNA that encodes a protein that has a specific amino acid sequence set forth in SEQ ID No. 2. One skilled in the art would have no trouble discerning the DNA that is claimed in newly amended claim 3. Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §112, first paragraph, written description rejection to claim 2 for the above reasons and claim amendment presented herein.

Claim 2 has also been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner contends that a “single nucleotide” would meet the limitations of this claim because it recites “a DNA of a gene” and “a sequence.” Applicants respectfully disagree.

Claim 2 has been canceled and its subject matter has been partly incorporated into claim 3(c). Applicants believe that the DNA of claim 3(c) cannot be interpreted as a

single nucleotide, because it “encodes a protein having the amino acid sequence of SEQ. ID No. 2.” One skilled in the art would understand that the DNA of this claim is directed to several nucleotides that encode the entire protein of SEQ ID No. 2.

For the above reasons, and in view of the claim amendments, applicants respectfully request reconsideration and withdrawal of this rejection under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

#### *Claim 10*

Claim 10 has been rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. The Examiner contends that the deposit of the plasmid pUSPT (Accession No. FERM BP-7932) is not in full compliance with 37 CFR §§1.803-1.809. Applicants respectfully disagree.

The Examiner contends that 37 CFR §1.808 sets forth that any deposit made under the terms of the Budapest treaty must be accompanied by a declaration or affidavit if the deposit is the subject matter of a patent application. Applicants respectfully disagree. 37 CFR 1.808 only sets forth the requirements of making a deposit. Applicants have previously submitted an international form that illustrates the fact that applicants have made a biological deposit under the Budapest Treaty in the International Depositary Authority under Accession No. FERM BP-7932 since March 1, 2002 (see paragraph 101 of the published application). Applicants believe that this verification is sufficient to comply with the rules for deposit set forth in 37 CFR §§1.803-

1.809, therefore applicants respectfully request reconsideration and withdrawal of this rejection under 35 U.S.C. §112, first paragraph.

**Response to 35 U.S.C. §112 Rejections, Second Paragraph**

Claims 2 and 3 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully disagree.

The Examiner contends that the phrases “of a gene encoding the protein SPT” and “within the nucleotide sequence” in claims 2 and 3 are unclear. Applicants have canceled claim 2 and amended claim 3 to further clarify the claimed invention. Applicants believe that these amendments render this rejection moot.

For the above reasons, and in view of the claim amendments, applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §112, second paragraph.

**Response to 35 U.S.C. §102 Rejections**

*Stratagene Catalog*

Claim 2 has been rejected under 35 U.S.C. §102(b) as being anticipated by the Stratagene catalog (Stratagene Cloning Systems, 1993). Applicants respectfully disagree with the rejection.

The Examiner alleges that the Stratagene catalog discloses the four nucleotides, each of which is a DNA recited in claim 2. Claim 2 has been cancelled and an isolated DNA that is recited in newly amended claim 3(c), into which the subject matter of claim

2 has been partly incorporated, cannot be interpreted as a single nucleotide, because it “encodes a protein having an amino acid sequence of SEQ. ID No. 2.” Applicants believe this amendment has overcome the rejection.

### *Invitrogen Catalog*

Claim 2 has been rejected under 35 U.S.C. §102(b) as being anticipated by the Invitrogen catalog (Invitrogen, 2001). Applicants respectfully disagree with the rejection.

The Examiner alleges that the Invitrogen catalog discloses all possible hexameric DNA sequences, and therefore they necessarily include a DNA of claim 2. Claim 2 has been cancelled and an isolated DNA that is recited in claim 3(c), into which the subject matter of claim 2 has been partly incorporated, can not be interpreted as a hexameric DNA, because it “encodes a protein having an amino acid sequence of SEQ. ID No. 2.” Applicants believe the rejection has been overcome by this amendment. Therefore, reconsideration and withdrawal of these §102 rejections to claim 2 are moot in view of the cancellation of claim 2.

### **CONCLUSION**

Applicants respectfully request reconsideration of the amended claims and urge that the present claims are in condition for allowance. Early and favorable action is earnestly solicited.

**AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees which may be required for this response, or credit any overpayment to Deposit Account No. 13-4500, Order No. 4439-4024.

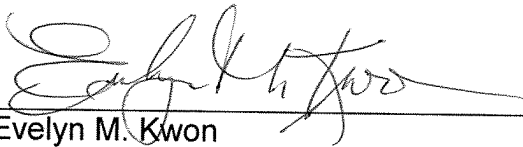
In the event that an extension of time is required, or which may be required in addition to that requested in a petition and for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 4439-4024.

Respectfully submitted,

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